

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HARTMUT SCHANDL, DIETFRIED SUSS
and ALBERT M.A. RIJCKAERT

Appeal No. 1997-3970
Application 08/391,379

ON BRIEF

Before JERRY SMITH, FLEMING, and FRAHM, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

Appeal No. 1997-3970
Application No. 08/391,379

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 2-35, which constitute all the claims remaining in the application.

The disclosed invention pertains to a cassette for use with a recording and reproducing apparatus. More particularly, the cassette contains at least one electrical impedance in which the value of the impedance defines a parameter of the cassette. The recording and reproducing apparatus detects the value of the impedance in the cassette and determines the cassette parameter therefrom.

Representative claim 35 is reproduced as follows:

35. An improvement in a system for recording and/or reproducing information signals on/from a record carrier, which system comprises an apparatus having a device for recording and/or reproducing information signals on/from said record carrier and a cassette adapted to be inserted into the apparatus, which cassette accommodates said record carrier and comprises at least one indicator; which by means of one of its parameters indicates at least one characteristic value of a fixed element of said record carrier, the apparatus comprising at least one detection device for the detection of the parameter of the indicator, which parameter indicates the at least one characteristic value, wherein the improvement

Appeal No. 1997-3970
Application No. 08/391,379

comprises at least one electrical impedance in the cassette as said indicator in said cassette, the impedance value of said impedance defining the parameter for the indication of at least one characteristic value of a fixed element of said record carrier of said cassette, and

the at least one detection device of the apparatus is adapted to detect the parameter defined by the impedance value of the at least one impedance.

The examiner relies on the following references:

Sawada et al. (Sawada)	5,434,721	July 18, 1995
	(filed May 26, 1993)	
Yoshii	60-231989	Nov. 18, 1985
Ozawa	02-201789	Aug. 09, 1990
Adel S. Sedra et al. (Sedra), <u>Microelectronic Circuits</u> , 2ND Edition, 1987 by CBS College Publishing, pages A-1 to A-13.		

The following rejections are before us on this appeal:

1. Claims 2, 14, 15, 27, 28 and 35 stand rejected under 35 U.S.C. § 102(b) as being anticipated by the disclosure of Ozawa.¹

2. Claims 2, 14, 15, 27, 28 and 35 stand rejected

¹ Our understanding of Ozawa and Yoshii is based upon translations provided by a contractor to the United States Patent and Trademark Office. Copies of these translations are attached to this decision.

Appeal No. 1997-3970
Application No. 08/391,379

under 35 U.S.C. § 102(e) as being anticipated by the disclosure of Sawada.

3. Claims 3-8, 16-21 and 29-34 stand rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of Ozawa or Sawada in view of Sedra.

4. Claims 9-13 and 22-26 stand rejected under 35 U.S.C. § 103 as being unpatentable over the teachings of Ozawa or Sawada in view of Sedra and Yoshii¹.

Rather than repeat the arguments of appellants or the examiner, we make reference to the brief and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of anticipation and obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the brief along with the examiner's rationale in support of the

Appeal No. 1997-3970
Application No. 08/391,379

rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the disclosures of Ozawa and Sawada do not fully meet the invention as recited in claims 2, 14, 15, 27, 28 and 35. We are also of the view that the evidence relied upon and the level of skill in the particular art would not have suggested to one of

ordinary skill in the art the obviousness of the invention as set forth in claims 3-13, 16-26 and 29-34. Accordingly, we reverse.

We consider first the rejection of claims 2, 14, 15, 27, 28 and 35 under 35 U.S.C. § 102(b) as being anticipated by the disclosure of Ozawa. Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.); cert. dismissed, 468 U.S.

Appeal No. 1997-3970
Application No. 08/391,379

1228 (1984); W.L. Gore and Associates, Inc. v. Garlock, Inc.,
721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert.
denied, 469 U.S. 851 (1984).

The examiner has indicated how he reads these claims on Ozawa [answer, pages 4-5]. Appellants argue that each of these claims recites that the impedance value defines the cassette characteristic and that Ozawa does not teach or imply the use of impedance values to encode cassette characteristics [brief, pages 4-7]. We note that the examiner has referred to an IC chip connected to part 2 of Ozawa as meeting this limitation.

We agree with appellants that Ozawa does not fully meet the invention of these claims. Ozawa's cassette is designed to carry a memory chip with information that can be bidirectionally communicated with the recording and reproducing unit. Appellants are correct that a memory chip is not an impedance and has no impedance value to indicate anything. The only impedance shown in Ozawa's Figure 3 would be the loading detector 8 which merely detects when the cassette has been inserted into the recording and reproducing

unit. The value of the impedance in loading detector 8 is neither discussed by Ozawa nor would its value be indicative of any property of the cassette itself. Since all the limitations of the rejected claims are not present in the disclosure of Ozawa, we do not sustain the rejection of these claims under 35 U.S.C. § 102(b) based on Ozawa.

We now consider the rejection of claims 2, 14, 15, 27, 28 and 35 under 35 U.S.C. § 102(e) as being anticipated by the disclosure of Sawada. The examiner has indicated how he reads these claims on Sawada [answer, pages 5-7]. Appellants argue that each of these claims recites that the impedance value contains the cassette characteristic and that Sawada's use of an IC chip does not teach or suggest the use of impedance values to encode cassette characteristics [brief, page 7]. Appellants also argue that Sawada's conductors 18 do not have impedance values and Sawada would not operate if the conductors were replaced with impedance elements [*id.*, page 8]. We note that the examiner has referred to the IC chip 15 or conductors 18 of Sawada as meeting this limitation.

We again agree with appellants that Sawada does not fully meet the invention of these claims. Sawada's cassette

is designed to convey information about the cassette to the recording and reproducing apparatus, but Sawada's cassette does not use an electrical impedance to convey this information. Sawada conveys information as to whether a cassette is an IC type cassette or a terminal type cassette. Figure 8 shows the IC type cassette whereas Figure 9 shows the terminal type cassette. Although the IC type cassette of Figure 8 does reveal that the cassette is an IC type cassette, it does not achieve this by use of an impedance value. The disclosed integrated circuit is not an impedance and has no impedance value to indicate anything. The terminal type circuit of Figure 9 has no impedance elements at all, and the examiner's position that ordinary conductors (no theoretical resistance) are impedance elements violates both the ordinary definition of the term and the disclosed meaning of the term. Since all the elements of these claims are not present in the disclosure of Sawada, we do not sustain the rejection of these claims under 35 U.S.C. § 102(e) based on Sawada.

We now consider the rejection of claims 3-13, 16-26 and 29-34 under 35 U.S.C. § 103. In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a

Appeal No. 1997-3970
Application No. 08/391,379

factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met,

the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellants have been considered in this decision.

Arguments which appellants could have made but chose not to make in the brief have not been considered [see 37 CFR § 1.192(a)].

As noted above, the examiner's rejections are based upon an interpretation of Ozawa or Sawada which is incorrect. Neither Ozawa or Sawada discloses or suggests at least one electrical impedance in the cassette wherein the impedance value defines the parameter of the cassette. The additional teachings of Sedra and Yoshii, which are used in the obviousness rejections, do not overcome the basic deficiencies in the primary references to Ozawa and Sawada.

Appeal No. 1997-3970
Application No. 08/391,379

Since the examiner improperly determined that the recitations of the independent claims were fully met by the disclosures of Ozawa or Sawada, the examiner has not addressed the obviousness of modifying any of the applied prior art references to result in a cassette having an electrical impedance as set forth in the claimed invention. Consequently, the examiner has failed to establish a prima facie case of the obviousness of the appealed claims. As noted by the case law cited above, failure to establish a prima facie case of obviousness requires that the rejection of claims 3-13, 16-26 and 29-34 under 35 U.S.C. § 103 be reversed.

Appeal No. 1997-3970
Application No. 08/391,379

In summary, we have not sustained any of the examiner's rejections of claims 2-35. Therefore, the decision of the examiner rejecting claims 2-35 is reversed.

REVERSED

)	
Jerry Smith)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
Michael R. Fleming)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
Eric Frahm)	
Administrative Patent Judge)	

Appeal No. 1997-3970
Application No. 08/391,379

JS/dm

Corporate Patent Counsel
U.S. Philips Corporation
Patent Department
580 White Plains Road
Tarrytown NY 10591